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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,475	12/07/2004	Dominique Beaufort	FR 020055	6119
24737 7590 09/01/2009 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
BROOKS, MATTHEW L.				
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3629				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/517,475

**Applicant(s)**

BEAUFORT ET AL.

**Examiner**

MATTHEW L. BROOKS

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to the RCE filing on 18 June 2009.

#### ***Drawings***

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because they are a direct copy of a National Stage PCT application.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

#### ***Specification***

3. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:  
(1) if a machine or apparatus, its organization and operation;

- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

4. The abstract of the disclosure is objected to because in a direct copy of a National Stage PCT application. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112 1<sup>st</sup>***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no teaching as to how the "proximity condition is *adapted accordingly as a function of the type of traversed zones*" (emphasis added). Nor does the spec enable one skilled in the art to "defining the service can be executed independently of the itinerary computation, and in that the services defined are stored in a current list *intended to be used during the itinerary computation*."

***Claim Rejections - 35 USC § 112 2<sup>nd</sup>***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 1-2 and 8, the word "means" is used as an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Nor through a search of specification is Examiner able to find corresponding structure to carry out function.

10. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: with respect to 1-2 and 8 see above; with respect to method claims 3, 5 -6 and program claim 7; no structure is tied to the claims. For example with respect to claim 3 - it is indefinite as to what or who "defines the at least one itinerary search" of the first limitation. An example of structural elements with respect to claim 7, there is not structure as to hardware the executable steps on processor are effecting or where how steps occur and where sent.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application EP 0 785 537 A1; 23.07.1997 (Toyota) in view of US 20020055852 A1 (Little) in further view of 2002/0167442 A1 (Taylor).

14. With respect to **claims 1, 2, 7 and 8** : Toyota teaches

A system, method and server comprising at least a communication network, a user entity and a

server entity (Fig 12), said user entity comprising:

means for defining at least one itinerary search criterion and at least one service (Fig 12, 110 – input device AND Fig 2b –“goal” AND C1, 50-53 “input means”);

means for sending an itinerary search request to said server entity via said communication network, said request comprising at least said search criterion and said service (Fig 12, 110 – input device and Fig 2b –“goal”);

means for receiving a response via said communication network (Fig 12, 110 – input device and Fig 2b –“goal”);

means for presenting said response (Fig 12, 120, display device),  
said server entity comprising:

means for receiving said itinerary search request (Fig 12, 110 – input device and Fig 2b –“goal”);

means for computing at least one itinerary from said search criterion by using a transport database (Fig 7 and Fig 1, 12 and C2, 25-35);

means for selecting at least one provider providing said service and fulfilling at least one proximity condition with respect to the computed itinerary by using a database of service providers (Fig 2 and Fig 9 provider equivalent to “restaurant” and C1, 55-60 database stores data on service facilities);

means for sending, to said user entity via said communication network, a response comprising the computed itinerary with localization of the selected provider (Fig 6).

Toyota fails to teach “itinerary considering forms of transportation” in proximity determination.

Little teaches when a restaurant comes up that meets user search criterion but requires a boat (different form of transportation) it is then considered a disqualifying

factor. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the teachings of Toyota to include the mode of transportation while planning a user's itinerary per the teachings of Little, for the advantage of not including locations that are only accessible by boat.

Further, Taylor teaches a GPS system that can determine route [0011], where data retrieved will be determined against mode of operation (bottom of [0015]), that mode of operation is different forms of travel, ([0032] – drive mode and fly mode); and adjusting the presentation of data to suit the mode of travel ([0040]). This all is in toto is equivalent to "proximity condition being determined in consideration of forms of transportation along said computed itinerary". It would have been obvious to one of ordinary skill to combine the teachings of Toyota - use in car, Little – use in car but discounting of routes not accessible by car, AND Taylor traveling in any form of transportation including walking, boating flying, because it is mere combination of old elements providing no unexpected results.

15. With respect to **claim 5** : Toyota teaches, wherein the computed itinerary traverses one or several zones each being of a certain type, and said proximity condition is adapted accordingly as a function of the type of traversed zones (Fig 11, A-B AND Fig 7, cells equivalent to zones).

16. With respect to **claim 6** : Toyota teaches above is characterized in that said step of defining the service can be executed independently of the itinerary computation, and in that the services defined are stored in a current list intended to be used during the

itinerary computation (This is interpreted as 2B as traveler proceeds through itinerary if unexpected obstacle occurs (traffic jam) then the system may recalculate itinerary based upon alternate services with in geographical area/zone/cell).

### ***Response to Arguments***

17. Applicant's arguments with respect to claims 1-3 and 5-8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew L. Brooks/  
Patent Examiner, GAU 3629  
August 31, 2009